REMARKS

In the Office Action,[1] the Examiner rejected claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0212682 to Nip ("*Nip*") in view of U.S. Patent No. 5,940,809 to Musmanno et al. ("*Musmanno*").

By this amendment, Applicants propose amending claims 1, 11, and 26. Claims 1-11 and 17-26 remain pending.

Applicants respectfully traverse the rejection of claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as being unpatentable over *Nip* in view of *Musmanno*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." *See* M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See* id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

Independent claim 1 recites a computer-implemented method for automatically filing documents relating to business transactions and for storing data relating to the business transactions, including:

> storing . . . the output data record with a first data area, a second data area, and an identification code, wherein the first data area is configured to be read by a first of the business applications, and the second data area is configured to be read by a second of the business applications.

Combinations of *Nip* and *Musmanno* fail to teach or suggest at least the claimed "output data record."

Nip discloses that a user creates a new output page. *Nip*, ¶ [0037]. However, *Nip's* output page does not include "a first data area" or "a second data area," "wherein the first data area is configured to be read by a first of the business applications, and the second data area is configured to be read by a second of the business applications," as recited in claim 1.

Musmanno fails to cure the deficiencies of *Nip*. *Musmanno* discloses a standard transaction format with a control section, a common section, and an application specific section. *Musmanno*, col. 5, lines 56-58. However, none of *Musmanno's* sections constitute the claimed "first data area" or "second data area" at least because *Musmanno* fails to teach or suggest that "the first data area is configured to be read by

<u>a first of the business applications</u>, and the second data area is configured to be read by <u>a second of the business applications</u>," as recited in claim 1 (emphasis added).

In view of at least the above deficiencies of the applied references, the Final Office Action has not clearly articulated a reason as to why the claim would be obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claims 11 and 26, while of different scope than claim 1, distinguish over *Nip* and *Musmanno* for reasons similar to claim 1. Claims 2-10 and 17-26 distinguish over *Nip* and *Musmanno* at least due to their dependence from one of the independent claims.

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the claims in condition for allowance. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing, Applicants submit that the claims are neither anticipated nor rendered obvious in view of the cited references. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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